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09/964,975	09/26/2001	Florian Max Kehlstadt	09623C-031810US	2943

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EXAMINER

MENGISTU, AMARE

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 08/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/964,975

Applicant(s)

KEHLSTADT, FLORIAN MAX

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10,16-30 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1,13**, and **14** of U.S. Patent No. **10/124,892**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '892 patent disclose applicant's claimed invention except that the computer mouse and detecting said mouse. However; it would have been obvious to one skill in the art at the time of the invention was made to recognize the input device of '892 could be any kind of input device including a mouse.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hinckley et al (2001/0011995)**.

5. As to claims 16 and 20; **Hinckley et al** clearly teaches a computer mouse comprising: a housing (figs.4-14); electronic circuit for detecting movement of said mouse and transmitting movement signals to a computer (page 5, col.1 [0072-0073]); a hand detection circuit for detecting the proximity of a user's hand to said housing and producing a hand detect signal (page 5, col.1 to col.2 [0076]).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 7-10,12-15, 18-19,21-23,29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hinckley et al (2001/0011995)** in view of **Goff et al (6,105,142)** and **Inoue et al (6,075,520)**.

As to claims 1-4,7-10,12-15,18-19, 21-23,26,29-30 **Hinckley et al** clearly teaches an input device/optical mouse **Hinckley et al** comprising: a housing (figs. 4A-4C); electronic circuitry for detecting user inputs and transmitting signals corresponding

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to said inputs to an electronic devices (page 7, col.1 [0091]); detecting movement of said optical mouse using optical detection and transmitting said movement signals to an electronic device external to said optical mouse (page 6, col.1, [0083]); a hand detection circuit for detecting the proximity of a user's hand to said housing and producing a hand detect signals (page 5, col.1 [0072], col.1 [0076] to col.2); simultaneously charging and discharging of capacitance coupled to electrodes, and producing a hand detect signal (page 5, col.2 [0077]). **Hinckley et al** has failed to teach a sleep mode circuit. **Goff et al** is cited to teach that it is well known to have a sleep mode circuit being responsive to a hand detection signal to awaken an electronic circuit from reduced power operation (see, col.11, lines 41-52, col.12, lines 26-44).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to combine the teaching of a sleep mode circuit as taught by **Goff et al** into the input device of **Hinckley et al**, because this is a power management system which will allow the user for managing power consumption in a computer system.

As to claims 7 and 8, wherein said hand detection circuit includes electrodes covering more than 25 percent of the underside surface (see, fig.4A (172)) and can be directly contacted simultaneously by the user's hand (figs. 6A-6D (602)).

**Hinckley et al** as modified by **Goff et al** did not teach explicitly teach that the hand detection circuit is a capacitive detection circuit. However, **Inoue et al** is cited to teach that a capacitive hand detection circuit is well known (see, Abstract) including a first and a second electrodes for capacitive connection with a user hand (fig.1 (X1-Xn),

Y1-Ym)); a first circuit coupled to said first electrode (fig.1 (13)); a second circuit coupled to said second electrode (fig.1 (13a)) for detecting for charging/discharging the capacitance (see, Abstract; col.4, lines 29-53).

Therefore, it would have been obvious to one skill in the art the time of the invention was made to incorporate the capacitive detection method of Inoue et al into the input device of **Hinckley et al**, since this is an alternative way of detecting hand in order to provide a small current detector circuit that is less affected by noise.

8. Claims 24,25,27,28,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hinckley et al** in view of **Goff et al** and **Bowen** (5,707,160).

As to claims 24,25,27,28,31, **Hinckley et al** (as modified by **Goff et al**) teaches applicant's claimed invention except a housing having a recess and shunt barrier for a light emitter and also filtering the ambient light from the light emitter. The patent of Bowen clearly teaches that it is well known for an input device light emitter to have a recess and a barrier (see, figs. 1 and 1A (8,9,54,56)) and an ambient light filtering system (col.2, lines 50-col.3, lines 27).


Therefore it would have been obvious to one skill in the art at the of the invention was made to have been motivated to use the light emitter system of **Bowen** into the device of **Hinckley et al**, because this is an other method of hand detecting so that correct data entry can be made without looking at the keyboard.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703)305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703)305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9600.

  
Amare Mengistu  
Primary Examiner  
Art Unit 2673

A.M  
August 10, 2003